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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,952	01/24/2001	Kazunobu Katoh	3709-0101P	2787

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EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 05/19/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/767,952	KATOH, KAZUNOBU
	Examiner	Art Unit
	Thorl Chea	1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15, 17 and 18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-15, 17 and 18 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The language in claim 1, "a separate photosensitive layer" in the claimed language "a separate photosensitive layer comprising a photosensitive silver halide and substantially no organic silver salt" should be changed to --said separate photosensitive layer – in order to further define the relationship of the amount of photosensitive silver halide in silver supplying layer and that of the separate photosensitive silver halide layer.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 12-13, 15, 17-18 are rejected under 35 U.S.C. 103(a) as obvious over EP0803764 (EP'764). See photosensitive layer which contains silver halide on page 3, lines 40-46; the non-photosensitive layer having organic silver salt and reducing agent therefore on page 5, lines 39-50 and page 25, lines 10-15; the formation of photosensitive and non photosensitive layer on page 25, lines 15-20; the coating of

non-photosensitve layer on the same surface of the support as said photosensitive layer on page 44, claim 21; on page 25, lines 5-8, it is disclosed that the photosensitive layer contains silver halide and the binder, the other components including a non-photosensitve silver salt, reducing agent therefore, toner hydrazine derivative, dye, filler surfactant and crosslinking agent may also added if necessary; the two or more photosensitive layer is disclosed on page 3 under "photosensitive layer". The photothermographic material of the EP'764 contains same photographic additives used in the present invention. Note for instance the enhancing agent such as hydrazine compound on page 21, lines 49-55; antifoggant such as halogenated on pages 21, lines 3-6.

The EP'764, therefore, suggests the heat developable material containing photosensitive silver halide and the non-photosensitive layer having an organic silver salt. See especially on page 5, lines 26-32 and line 49-50. It would have understood that organic silver halide is optional in the photosensitive layer and the non-photosensitive layer does not necessarily contain silver halide. The scope of claimed 1 is directed the relationship silver supplying layer and the photosensitive layer wherein the silver-supplying layer comprising an organic silver salt and photosensitive silver halide in amount that is 10 wt % or less of a coated amount of photosensitive silver halide in a separate photosensitive layer and the separate photosensitive layer comprising a photosensitive halide and substantially no organic silver salt. The scope of the amount of photosensitive silver halide encompasses 0.0 weight % of a coated amount of photosensitive silver halide in a separate photosensitive layer, which is the

material containing photosensitive layer and light-insensitive layer taught in EP'764. The scope of the process in claim 12 encompasses the any amount of light sensitive silver halide in any amount in the silver-supplying layer and any amount of organic silver salt in the separate photosensitive layer. The EP'764 therefore suggests heat developable material having structural relationship within the scope of the claimed invention, and therefore renders the claimed invention *prima facie* obvious. Therefore, the reference suggests and makes obvious the claimed subject matter. *In re Malagari*, 182 USPQ 549.

5. Claims 4-11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0803764 (EP'764) as applied to claims 1-3, 12-13, 15, 17-18 above, and further in view of Murray ('324), Murray et al ('515) and Toya et al (Toya).

The halogen precursor has been known in Toya as antifoggant for photothermographic material and the electron transfer such as hydrazine and alkene derivative and isooxazole derivative have been known as contrast enhancer and taught in Murray, and it would have been obvious to use thereof in the material of EP'764 to improve the image contrast thereof to provide the invention as claimed.

#### ***Response to Arguments***

6. Applicant's arguments filed March 3, 2003 have been fully considered but they are not persuasive because of the rejection set forth above. The invention as claimed would have at least found *prima facie* obvious to the worker of ordinary skill in the art at the time the invention was made since the EP'764 suggested the photothermographic material containing more than one layer including the photosensitive silver halide and

non-light sensitive layer such as presented in the above rejection. The applicants argument was directed to the rejection under 35 USC 102(b) rather than the rejection under 35 USC 103. EP'764 may not exemplify the material of the claimed invention, but at least suggest the claimed material. The photosensitive silver halide, non-photosensitive organic silver salt and the electron transfer agent are common ingredient for photothermographic material and taught in the EP'764. The remaining issue is whether the use of the photosensitive silver halide and the non-photosensitive organic silver salt in a separate layer would have been found unobvious to the worker of ordinary skill in the art. First, the photothermographic material having photosensitive layer and light insensitive is suggested in EP'764. This suggestion would render the claimed invention *prima facie* obvious. Second, the worker of ordinary skill in the art would have expected that use of photosensitive silver halide in a same layer with the non-photosensitive organic silver salt or in a separate layer would provide at least similar results so long as the photosensitive silver halide is in catalytic relationship with the non-photosensitive organic silver salt layer. In this case, the separate photosensitive silver halide layer presented in the claimed invention is still in catalytic relationship with the non-photosensitive organic silver salt. Accordingly, the claimed material would have been found *prima facie* obvious to the worker of ordinary skill in the art in absence of providing further convincing evidence showing otherwise.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea   
May 16, 2003



Thorl Chea  
Primary Examiner  
Art Unit 1752